



#13
1/16/03
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:

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Tai-Her YANG

)

Group Art Unit: 3681

Serial Number: 09/580,968

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Examiner: D. Wright

Filed: May 30, 2000

)

For: Distributed Differential Coupling Combined Power System

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REQUEST FOR RECONSIDERATION

GROUP 3600

Honorable Commissioner For Patents
Washington, D.C. 20231

Sir:

This paper is in response to the Official Action dated October 11, 2002.

Reconsideration of the application is respectfully requested on the grounds that the Examiner has applied an incorrect standard of **materiality** to the proposed drawings, namely separation of the test for materiality from the test for support in the original disclosure. Instead, it is respectfully submitted that the test for "materiality" of drawing changes is the same as the test for "new matter," and that the proposed new drawings are not "*materially*" different than the drawings of U.S. Patent No. 5,547,433, on which the present application for reissue is based because they are fully supported by the original specification.

As explained in the previous response, the proposed new drawings are fully supported by the original specification of U.S. Patent No. 5,547,433. In fact, the proposed new drawings have been introduced for the purpose of correcting certain errors in the drawings of U.S. Patent No. 5,547,433, and in particular for the purpose of conforming the drawings of U.S. Patent No. 5,547,433 to the specification of U.S. Patent No. 5,547,433.

In the Official Action, the Examiner indicates that whether the drawings are supported by the original specification is irrelevant if the drawings are "materially different." In reply,

Applicant respectfully submits that the test for whether drawings are materially different depends on whether the drawings are supported by the original specification, that if the drawings are not supported by the original specification they must be considered "materially different" no matter how minor the change, and that if the drawings are supported by the original specification should not be considered materially different no matter how substantial the differences. The test for material difference makes no sense unless it is a "new matter" test.

Essentially, the purpose of the present re-issue application is to correct errors in the original drawings, namely that the drawings did not conform to the specification. In order to correct these errors, the drawings of the patent have been amended to conform exactly to the original specification. To permit such correction of errors is the exactly why the re-issue statute was enacted, and to associate "materiality" with the size of the errors as the Examiner has done, rather than the nature of the errors and corrections, defeats the purpose of the reissue statute. In a conclusion worthy of Kafka or Joseph Heller (the author of *Catch 22*), the Official Action now holds that a discrepancy between the original specification and the original drawings is not a "reissuable error" *because the drawings have been changed to correct the discrepancy*. This novel interpretation of the "materially different" requirement, as prohibiting correction of discrepancies, makes no sense.

Errors in the drawings are clearly a proper basis for as re-issue application. 35 USC §251 clearly states that a reissue is appropriate whenever a patent is wholly or partially inoperative or invalid "by reason of a defective specification or drawing...." A defective drawing is logically one in which the drawing does not match the description of the invention. If the patentee is not allowed to amend the drawings to correct discrepancies between the drawings and the original specification, then the "defective drawing" provision in 35 USC §251 makes no sense. This is all that the patentee has done in the present application, *i.e.*, **the proposed new drawings do nothing more than correct discrepancies between the original specification and drawings**. The fact that there were several such discrepancies, described in detail in the previous response, should not be a grounds for holding that the drawings are "materially different." If one or two

discrepancies can be corrected, then it should be possible to also correct three or four such discrepancies.

It is respectfully submitted that the test for whether drawings are "materially different" is not the number of changes, but rather whether the drawings are supported by the original specification. **A very minor change not supported by the original specification should be considered "materially" different, whereas a dozen fairly major changes that are nevertheless supported by the original specification should not be considered "materially."** It appears that the test for materiality chosen by the Examiner is improperly based not on support in the original disclosure, but simply on the number of differences.

If the test for whether differences are "material" is essentially a "new matter" test to determine whether the revised drawings are supported by the original disclosure, so that minor unsupported changes are considered materially different while major supported changes are considered to be acceptable, then the proposed new drawings clearly are not materially different than the original drawings since each of the changes has support in the original specification, and since the changes are made solely to conform the drawings to the original specification, as follows:

1. The motor armature and field generating structure depicted in the proposed new drawing are described in **col. 4, lines 17-27** of the '433 patent:

...For the case of AC power generation output functions, the electromagnetic coupling device M101 is employed as an electrical machine with AC power generating functions and made up of a permanent magnet or winding excited, variable frequency field type of electrical device, or a brushed alternator type of electrical device, armature winding being commonly installed with the conducting rings for AC output and with the commutators for DC input/output, as a result of which the AC output can be a variable frequency output or a constant frequency output depending on the engine constant speed control.

2. The double bearing structure shown in the proposed new drawing is not only supported but required by the specification of the '433 patent because, as explained in **col. 3, lines 39-41**, the electromagnetic coupling device M101 is:

...made up of a rotational field generating structure and a rotor. . . ,

i.e., both the rotor and the field generating structure are mounted for rotation. Without the double bearing structure depicted in the drawings, the field generating structure would not be able to rotate. Again, the manner in which the double bearings are depicted are entirely conventional, and all of the corresponding structural details follow directly from, and are necessary to, the depiction of the field generating structure as rotating. If this were not the case, there would be no possible use for clutch 101, which is:

. . . controlled by the central controller CCU101 and installed between the rotational field generating structure and the rotor. . . .

3. Finally, the respective connections to shaft S101 and the rear gearbox GB101 are described in **col. 3, lines 40-44**, as follows:

. . . is made up of a rotational field generating structure and a rotor, and. . . the rotational field and the rotor are respectively coupled with the transmission middle shaft S101 and the input shaft of a rear differential gear box GB101. . . .

With respect to the double bearings, in particular, it is illogical to conclude that there is no reissuable error in the original drawings—since the original drawings fail to illustrate any of the double bearings **required** by the original specification. To omit a required element is clearly an error, and to amend the drawings to show the required element is clearly not new matter, so long as the required element does not include any details not inherent in the required element.

In summary:

- I. **because clutch CL101, a rotational field generating structure, field windings or permanent magnets on the field generating structure, a rotor, a DC commutator, and AC conducting rings are all described in the specification**

of the patent and were erroneously omitted from the drawings of U.S. Patent No. 5,547,433, and

II. because the drawings have merely been amended to show these elements and nothing more, all of the other details of Fig. 1 being identical to those of the originally filed drawings,

it is respectfully submitted that the proposed new drawings **are not materially different** than the original drawings and do **not** constitute **new matter**, and therefore entry of the drawings and passage of the application to issue is respectfully requested.

Respectfully submitted,

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By SC

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Date: January 13, 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: TAI-HER YANG

SERIAL NO.: 09/580,968

FILED: May 30, 2000

FOR: DISTRIBUTED DIFFERENTIAL COUPLING
COMBINED POWER SYSTEM

GROUP ART UNIT: 3681

EXAMINER: D. Wright

ATTY. REFERENCE: YANG3118/EM/BEU



THE COMMISSIONER FOR PATENTS
Washington, D.C. 20231

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GROUP 3600

Sir:

Transmitted herewith is a communication/amendment in the above-identified application.

- Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted.
- A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.
- No additional fee is required.

The fee, if any, has been calculated as shown below:

Fee Basis	Number of Claims After Amendment	Highest Number Previously Paid For	Extra Claims	Small Entity	Full Fee
Total Claims	-	¹	³ =	$\times \$ 9 =$	$\times \$ 18 =$
Independent Claims	-	²	³ =	$\times \$ 40 =$	$\times \$ 80 =$
<input type="checkbox"/> First Presentation of Proper Multiple Dependent Claim				$+ \$135 =$	$+ \$270 =$
			TOTAL		

¹ If less than 20 enter 20.

² If less than 3 enter 3.

³ If less than 0 enter 0.

- Please charge my Deposit Account Number 02-0200 in the amount of \$_____ A duplicate copy of this sheet is attached.
- A check in the amount of \$_____ is attached.
- The Commissioner is hereby authorized to charge any additional fees associated with this communication, including fees due under 37 CFR 1.16 and 37 CFR 1.17 or credit any overpayment to Deposit Account Number 02-0200. A duplicate copy of this sheet is attached.
- Also enclosed is/are:

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23364

PATENT TRADEMARK OFFICE

DATE: January 13, 2003

Respectfully submitted,


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